

REMARKS

Reconsideration of the above-identified application is respectfully requested. Finally making the restriction final is noted with appreciation. Entry of the foregoing amendment is proper because the amendment merely cancels claims drawn to a non-elected invention.

Claim 3 was rejected as indefinite. Original claim 3 clearly recited "step (c)", and was amended to repeat the definition of step (c) from claim 1. The final Office Action alleges that it is in response to the amendment filed August 25, 2003, yet the Examiner continues the rejection of claim 3 *in hoc verba* without regard to the amendment made to the claim since the previous Office Action. Was the previous amendment entered or not? The Examiner assumes for the purpose of examination that "comparison" "means 'the comparison of the first count to the least one count threshold.'" Why does one "assume" explicit claim language?

The undersigned was taught as an Examiner that if a claim is indefinite, it cannot be further examined because, by definition, its meaning is unknown. End of story. Assumptions are pointless. It is respectfully submitted that, if the claim can be interpreted well enough to make an assumption that justifies further examination, then the claim was not indefinite in the first place. Here, the situation is different. A rejection was made. Applicants disagreed with the rejection but nevertheless amended a claim, making the claim repetitious. Now, the Examiner ignores the amendment and nobly assumes an interpretation in the name of advancing prosecution. It is respectfully submitted that prosecution would be better advanced by reading the amendment and examining the claims as amended.

Claims 3–6 are submitted to be definite because the rejection thereof makes no sense by "assuming" existing language. If the assumption makes the claim definite then so too should the amendment make the claim definite.

Claims 1–3 were rejected as anticipated by Sullivan. Claim 1 recites "comparing the signals to each other and to at least one threshold." In the Sullivan patent, signals S1, S2, and S3 (FIG. 8) are input signals. There is no basis for identifying one of the three signals as a "threshold", particularly when the patent itself does not disclose any of these signals as a threshold. On the contrary, the Sullivan patent

explicitly discloses that the signals are input signals. It is respectfully submitted that the Examiner is ignoring express disclosure to support the rejection.

A patent specification are addressed to one of ordinary skill in the art. Although patent examiners are not ones of ordinary skill in the art, *Office personnel must always remember to use the perspective of one of ordinary skill in the art. Claims and disclosures are not to be evaluated in a vacuum. {MPEP §2106}*

Claims 1–3 distinguish over the prior art because the Examiner is distorting the prior art to support the rejection. There is no “threshold” as that term is understood by those of skill in the relevant art.

The Examiner alleges that the signals are not generated identically. The Sullivan patent discloses, column 11, lines 14–16, the following.

“each of the detectors 106 outputs an electric signal in response to radiation incident upon the detector.”

If this statement does not describe that the signals are *generated* identically, it is hard to imagine a more clear way to say it. The Examiner’s comment could be interpreted as saying that the *signals* are not identical. This is true but irrelevant. The *manner* in which the signals are generated *is* the same for all signals. The signals are *input* signals, not reference signals, and that is the point.

Note that claim 1 recites comparing the inputs signals (plural) to a threshold. Even if one (mis)construes the disclosure of the Sullivan patent to pick a signal as a threshold, **both** of the other signals are not compared to the threshold. A comparison of applicants’ FIG. 2 with FIG. 20 of the Sullivan patent clearly shows that it is **impossible** in the Sullivan patent to compare **two** signals to a threshold. For example, let S3 be the threshold. S3 is compared only with S2, not with S1 as required by claim 1. The same is true for any combination of signals picked.

MPEP §2116.01: “All the limitations of a claim must be considered when weighing the differences between the claimed invention and the prior art in determining the obviousness of a process or method claim. See MPEP §2143.03.”

[emphasis in original]

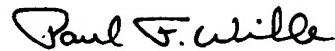
No less is true for determining anticipation. It is respectfully requested that the Examiner comply with the MPEP.

Claim 1 distinguishes over the Sullivan patent because the Examiner is ignoring explicit claim language to make the rejection.

Claim 1 recites "converting a plurality of binary representations into a first count" [emphasis added]. During normal operation, the apparatus disclosed in the Sullivan patent operates on a single binary representation. A count of 1 from counter 312 clears the counter. There is no conversion of a plurality of binary representations into a count. It is, therefore, respectfully submitted that there is no anticipation.

In view of the foregoing amendment and remarks, it is respectfully submitted that claims 1–6 are in condition for allowance and a Notice to that effect is respectfully requested.

Respectfully submitted,



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